



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,162	09/03/2004	Eros Masi	04147	5467
23338	7590	05/01/2006	EXAMINER	
DENNISON, SCHULTZ, DOUGHERTY & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314			MULLEN, THOMAS J	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/505,162

Applicant(s)

EROS ET AL.

Examiner

Thomas J. Mullen, Jr.

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/30/04</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

Art Unit: 2612

1. The specification is replete with grammatical and idiomatic errors. The specification should be revised to remove such errors, where possible. Examples of such errors are:

"tamper the devices" (page 1, lines 29-30);

"tampers the plastic belt" (page 2, line 5);

"who wears the device...should have the fingerprints and/or retina and/or the voice examined" (page 3, lines 23-25);

"underskin chip" (page 4, line 16; i.e., "underskin" does not appear to be a word); and

"a second sensor for controlling the heart beat and the temperature" (page 4, lines 27-29; i.e., it appears "controlling" should be a term such as --sensing--).

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because (i) they do include the following reference character(s) not mentioned in the description: 11' and 12 (see Figs. 3 and 1, respectively); and (ii) they do not include the following reference character(s) which are mentioned in the description: 60 (see page 8, line 1).

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following elements must be shown or the feature(s) canceled from the claim(s):

in the bracelet unit 1 (having structural elements 2-3 and 10-11 and electronic components 4-7), the "means for receiving" and "means for transmitting" signals from/to the central unit 40, as generally recited in claims 1 and 4;

in the bracelet unit, the "means for detecting position data" from the GPS system (20,22) as generally recited in claims 1 and 4--in particular, "a GPS device that processes satellite signals", as recited in claim 7;

in the bracelet unit, the "means for detecting tamper of the bracelet", as generally recited in claims 3 and 6;

in the bracelet unit, the "means for aligning (the retina scanner) with the eye of the individual", as recited in claim 5; and

"an underskin chip" and an associated "system integrated in the bracelet", as recited in claim 8.

Art Unit: 2612

No new matter should be entered.

It is noted that, in the disclosure, the bracelet unit is described as having a "chip" 7 (which might be capable, or have components which are capable, of carrying out some of the functions described above), but that no details whatsoever are provided about this "chip" as to its operative components or particular functions that the chip is capable of carrying out. (See paragraphs 5-6 below.) Also, note that elements whose details are not essential for a proper understanding of the invention (such as means for aligning the retina scanner) may be depicted schematically by a "labeled rectangular box" per 37 CFR 1.83(a).

4. As to paragraphs 2-3 above, corrected drawing sheets in compliance with 37 CFR 1.121(d)--and/or amendment to the specification to add reference character(s) present in the drawings to the specification in compliance with 37 CFR 1.121(b)--are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The present disclosure is considered non-enabling as to how the "bracelet unit" transmits or receives signals (either to/from the "central unit", or from the GPS network), since no means whatsoever are disclosed in association with the bracelet unit--note operative components 4-7 thereof--which are capable of transmitting and/or receiving signals. Further, the disclosure fails to teach how "tamper" detection (with respect to the bracelet) is carried out. As mentioned above in paragraph 3, for example, no details whatsoever are provided about "chip" 7 as to its operative components or particular functions that the chip is capable of carrying out. Applicant mentions, in the Summary of the Invention (see page 4, lines 6-8), a "module comprising a processor and a programmed EEPROM" (for integrating various "means" discussed in the preceding two paragraphs of the specification), but there appears to be no association mentioned between this "module" and the chip 7.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At the end of claim 1, it is unclear how "...and comparison with data previously stored" relates to the recitation immediately preceding it ("receiving by the central unit said set of signals"); i.e., it is unclear whether it is being implied that the central unit, in fact, carries out the "comparison".

Claim 1, line 8 and claim 4, line 7, "detecting position data" is indefinite, i.e. it is unclear whether the parameter or condition being detected is "position" per se or "data" per se (put another way, it is unclear how "data" per se is capable of defining a parameter or condition to be detected).

Likewise, in claim 3, last 3 lines, "detecting data of presence...and/or data of tampering" is indefinite.

Likewise, in claim 6, line 2, "detecting data of presence" is indefinite.

Art Unit: 2612

Claim 9, lines 1-2, "characterized by having" is indefinite as to which of the previously recited elements (i.e., the "bracelet unit" as a whole, or one or more of the particular components of the bracelet unit) "ha(s)" the particular shape recited.

9. Claims 1-9 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where claims 1 and 4 recite a "bracelet unit" (see claim 1, line 4 and claim 4, line 1), subsequent recitations of "said (or the) bracelet" lack clear antecedent basis, as they omit the term "unit". See claim 1, lines 7-9 (total of 3 occurrences); claim 3, last line; and claim 4, line 7.

Claim 3, last line, it appears that after "tampering" should be inserted --with--.

At the beginning of claims 5-9, "Unit" should be --A unit-- or --The unit--.

Claim 6, line 3, it appears that "tamper of" should be --tampering with--.

10. Claims 1-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, and/or the objection(s) under 37 CFR 1.75(a), set forth in this Office action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The art cited by applicant is made of record; LaDue (US 5889474) is noted as teaching a bracelet unit 167 used in combination with a "biometric" implant ("underskin") chip 162 and a handheld terminal 100, the bracelet and terminal in combination having tamper detection and GPS features, but LaDue fails to teach at least receiving, at the bracelet unit, a "verification signal" from a central unit. Hamilton (US 2005/83171, eff. date 12/10/01), Sloan et al (US 5023901) and Brooks (US 6898299, eff. date 9/15/99, see e.g. Figs. 39 and 185a-f and cols. 23 and 53) are cited to further show the state of the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 571-272-2965. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.


Art Unit: 2612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJM

  
THOMAS MULLEN  
PRIMARY EXAMINER  
AU 2612